

REMARKS

I. STATUS OF THE APPLICATION

Claims 23-43 were filed in the original application. In the Response to Office Action mailed March 17, 2006, claims 23 and 30 were amended, claims 28-29 and 35-43 were cancelled, and claims 44-55 were added. In the Response to Final Office Action mailed July 6, 2006, claim 30 was amended, and claims 23-27 and 44-49 were cancelled. In the Amendment and Response to Final Office Action of April 20, 2007, claims 30-33, and 50-54 were amended, claim 34 was cancelled, and claims 56- 62 were added. In the Notice of Allowance mailed September 19, 2007, claims 30-33, and 50-62 were entered into allowance. In the Response to Office Action mailed March 21, 2008 claims 30, 52, 53 and 61 were amended. In the Amendment and Response to Office Action mailed July 9, 2008, claims 30 and 53 were amended. In the telephonic Interviews of August 14, 2008 and August 20, 2008 the Examiner agreed to amend claim 30 by replacing the phrase “and/or” with the word “and” via an Examiner’s amendment, thereby reverting back to language previously presented in claim 30. (Record of Interview Substance of October 28, 2008 pages 1-2.) Claim 53 was amended to correct a typographical error. Applicants filed a Request for Continued Examination with a Supplemental Information Disclosure Statement on October 28, 2008. Therefore, claims 30-33 and 50-62 are currently pending.

II. CLAIM REJECTIONS

In the Office Action of February 23, 2009 the Examiner has made 20 rejections. The currently pending rejections are:

1. Claims 30, 53 and 60 are rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 14-17 of U.S. Patent 7,312,026 B2.

2. Claims 31 and 57 are rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 14-17 of U.S. Patent 7,312,026 B2 in view of Campbell et al. (Journal of Virological Methods (1996) 57: 175-179) (hereinafter “Campbell”).
3. Claims 32, 50-52, 58, 61 and 62 are rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 14-17 of U.S. Patent 7,312,026 B2 in view of Koster et al. (WO 98/20166) (hereinafter “Koster”).
4. Claims 33, 54-56 and 59 are rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 14-17 of U.S. Patent 7,312,026 B2 in view of Vanderhallen et al. (Journal of Clinical Microbiology (1998) 36(12): 3463-3467) (hereinafter “Vanderhallen”).
5. Claims 30-33 and 50-62 are allegedly directed to an invention not patentably distinct from claims 14-17 of commonly assigned U.S. Patent No. 7,312,036. Commonly assigned U.S. Patent 7,312,036 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.
6. Claims 30-32 and 50-58 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 23-29 of copending U.S. Application No. 11/869,449.
7. Claims 30, 32, 50-53, 56-58 and 60 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, and 10 of copending U.S. Application No. 11/331.987.

8. Claims 30, 32, 50-53, 56-58 and 60 are allegedly directed to an invention not patentably distinct from claims 1-3, 6, 8, and 10 of commonly assigned U.S. Application No. 11/331,987. Commonly assigned U.S. Application No. 11/331,987 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.
9. Claims 30-33 and 50-59 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 88, 89, 92-94, 98, 112-120, 122, 123, 125, 130, 131, 133, 140-148, 150-154, 156, 171-179, 181-183, and 200-206 of copending U.S. Application No. 10/728,486.
10. Claims 30-33 and 50-59 are allegedly directed to an invention not patentably distinct from claims 88, 89, 92-94, 98, 112-120, 122, 123, 125, 130, 131, 133, 140-148, 150-154, 156, 171-179, 181-183, and 200-206 of copending U.S. Application No. 10/728,486. Commonly assigned U.S. Application No. 10/728,486 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.
11. Claims 30-33, 50-53, and 57-62 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 23, 27, 28, 33, 36-44, 53, 55-68, 71-74, and 80-94 of copending U.S. Application No. 11/929,910.
12. Claims 30-33, 50-53, and 57-62 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 29, 30, 34, 35, 40, 43-50, 51, 60, 62-75, 78-81, 87-99, and 101 of copending U.S. Application No. 11/929,930.

13. Claims 30-33, 50-53, and 57-62 are allegedly directed to an invention not patentably distinct from claims 29, 30, 34, 35, 40, 43-50, 51, 60, 62-75, 78-81, 87-99, and 101 of copending U.S. Application No. 11/929,930. Commonly assigned U.S. Application No. 11/929,930 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(c), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.
14. Claims 30-33, 50-53, and 57-62 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 21, 22, 28-32, 35-50, 53, 54, 57, 60-67, 76-84, and 87-90 of copending U.S. Application No. 11/930,108.
15. Claims 30-33, 50-53, and 57-62 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 22, 23, 28, 29, 34, 37-45, 54, 56-69, 72-75, and 78-89 of copending U.S. Application No. 11/930,017.
16. Claims 30-33, 50-53, and 57-62 are allegedly directed to an invention not patentably distinct from claims 22, 23, 28, 29, 34, 37-45, 54, 56-69, 72-75, and 78-89 of copending U.S. Application No. 11/930,017. Commonly assigned U.S. Application No. 11/930,017 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(c), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.
17. Claims 30-33, 50-53, and 57-62 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 50, 51, 56, 57, 62, 65-73, 82, 84-97, 100-103, and 109-123 of copending U.S. Application No. 11/930,002.
18. Claims 30-33, 50-53, and 57-62 are allegedly directed to an invention not patentably distinct from claims 50, 51, 56, 57, 62, 65-73, 82, 84-97, 100-

103, and 109-123 of copending U.S. Application No. 11/930,002.

Commonly assigned U.S. Application No. 11/930,002 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.

19. Claims 30-33, 50-53, and 57-62 are provisionally rejected on the ground of alleged nonstatutory obviousness-type double patenting as being unpatentable over claims 35, 36, 41, 42, 47, 50-58, 67, 69-82, 85-88, 91-102, 106, and 107 of copending U.S. Application No. 11/929,707.
20. Claims 30-33, 50-53, and 57-62 are allegedly directed to an invention not patentably distinct from claims 35, 36, 41, 42, 47, 50-58, 67, 69-82, 85-88, 91-102, 106, and 107 of copending U.S. Application No. 11/929,707. Commonly assigned U.S. Application No. 11/929,707 would allegedly form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.

A. Double Patenting and Common Ownership

In the office Action of February 23, 2009 the Office notes:

“A timely filed terminal disclaimer in compliance with C.F.R. 1.32(c) or 1.32(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.” (Office Action of February 23, 2009, pages 2-3.)

A terminal disclaimer in compliance with 37 C.F.R. §1.32(c) has been filed to overcome the actual and provisional rejections based on nonstatutory double patenting.¹

Ibis Biosciences is the sole assignee of U.S. Patent No. 7,312,036, the rights thereto having been assigned to Isis Pharmaceuticals on June 27, 2005, and recorded on July 8, 2005 at Reel/Frame 016491/0763, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019691/0682.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 11/869,449, which is a continuation of U.S. Patent Application No. 10/660,122, the rights thereto having been assigned to Isis Pharmaceuticals on February 4, 2004, and recorded on February 6, 2004 at Reel/Frame 014315/0162, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019690/0036.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 11/331,987, the rights thereto having been assigned to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019691/0371, which is a continuation of U.S. Patent Application No. 10/156,608, the rights thereto having been assigned to Isis Pharmaceuticals on July 2, 2001, and recorded on November 13, 2002 at Reel/Frame 013482/0955, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019690/0036.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 10/728,486, the rights thereto having been assigned to Isis Pharmaceuticals on May 14, 2004, and recorded on June 4, 2004 at Reel/Frame 014708/0833, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019691/0584.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 11/929,910, which is a continuation of U.S. Patent Application No. 11/869,449, which is a

¹ The terminal disclaimers are filed to further prosecution of the present application. In filing these disclaimers, Applicants are not agreeing with the basis of the rejections. For example, Applicants believe that certain of the rejections mis-characterize the Koster patent with respect to its use and discussion of base composition analysis. However, the filing of the terminal disclaimer renders these rejections moot.

continuation of U.S. Patent Application No. 10/660,122, the rights thereto having been assigned to Isis Pharmaceuticals on February 4, 2004, and recorded on February 6, 2004 at Reel/Frame 014315/0162, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019690/0036.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 11/929,930, which is a continuation of U.S. Patent Application No. 10/660,998, the rights thereto having been assigned to Isis Pharmaceuticals on February 4, 2004, and recorded on February 5, 2004 at Reel/Frame 014310/0117, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019690/0036.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 11/930,108, which is a continuation of U.S. Patent Application No. 10/754,415, the rights thereto having been assigned to Isis Pharmaceuticals on November 15, 2004, and recorded on December 16, 2004 at Reel/Frame 015473/0192, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019691/0541.

Ibis Biosciences is the sole assignee of U.S. Patent Application No. 11/930,017, which is a continuation of U.S. Patent Application No. 11/331,987, the rights thereto having been assigned to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019691/0371, which is a continuation of U.S. Patent No. 7,108,974, the rights thereto having been assigned to Isis Pharmaceuticals on July 2, 2001, and recorded on November 13, 2002 at Reel/Frame 013482/0955, and from Isis Pharmaceuticals to Ibis Biosciences Inc., on August 14, 2007, and recorded on August 14, 2007 at Reel/Frame 019690/0036.

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Applicants assert that to the extent that the cited patent applications were co-existing at the time the instant invention was made, the present response to Office Action of February 23, 2009 makes reference to recorded assignment in each of the commonly owned applications. Thus, evidence has been provided showing that the issued patent is commonly owned with this application in accord with 37 C.F.R. §1.120(b).

In view of the above, Applicants requests that these rejections be withdrawn.

CONCLUSION

Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

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/David A. Casimir/

David A. Casimir
Registration No. 42,395

CASIMIR & JONES SC
440 Science Drive, Suite 203
Madison WI 53711
(608) 218-6900